

REMARKS

Claims 1-15 and 32-46 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. Asserted Obviousness of Claims 1-8, 11-15, 32-39, and 42-46

I.A. Basis of Rejections

The examiner rejects claims 4, 5, 36, and 37 under 35 U.S.C. § 103(a) as obvious over *Westrope et al.*, Method and Apparatus for an Interactive Computerized Catalog System, U.S. Patent 5,721,832 (Feb. 24, 1998) in view of *Tsevdos et al.*, Digital Information Accessing, Delivery and Production System, U.S. Patent 5,734,719 (Mar. 31, 1998).¹ This rejection is respectfully traversed.

The examiner states that:

As per claims 1, 3, 8, 11-15, 32-35 and 42-46, *Westrope et al.* teach a method in a primary data processing system (catalog data processor 67) for managing a catalog (col. 7, lines 13-15), method comprising: sending a catalog and user information to a plurality of secondary data processing system located in a network data processing system (marketing data processor 75, accounting processor 73); receiving an order from one of the plurality of secondary data processing systems (col. 7, lines 23-26); and processing the order, in response to receiving the order (col. 7, lines 28-30). *Westrope* does not disclose allocating the inventory but *Tsevdos* discloses allocating floor space to all of that available inventory regardless of the popularity of stocked materials and this kind of allocation can be associated with the catalog to the plurality of secondary processing systems as claimed (col. 1, line 51-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the service allocation module as taught by *Whitehead* into the system of *Westrope* because it would provide accountability of the communicated and networked information to have on-demand and real-time customer satisfaction.

¹ The examiner states that claims 4, 5, 36, and 37 are rejected. However, in the body of the rejection the examiner refers to claims 1-8, 11-15, 32-39, and 42-46. Applicants therefore address the rejection as if these claims are rejected under the rationale presented on pages 2 and 3 of the Office Action of April 21, 2005.

As per claim 2, *Westrope et al* teach a system that sends an update to the catalog to the plurality of secondary data processing systems as claimed (col. 9, lines 57-61).

As per claims 6, 7, 38, and 39, *Westrope et al* teach a system that is capable of providing a shopping card data (items ordered by the user are stored in a safe place) from the secondary data processing system as claimed.

As per claims 4, 5, 36, and 37, neither *Westrope* nor *Tsevdos* teaches allocation of the inventory upon a detection of a condition which is a threshold but it is well known to set a condition when determining whether or not an inventory is necessary because it would help determining the location of missing products, the examiner takes Official notice as such.

Office Action of April 21, 2005, pp. 2-3.²

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990).

Applicants first address the rejection against claim 1. Claim 1 is as follows:

1. A method in a primary data processing system for managing a catalog, the method comprising:
 - sending a catalog and user information to a plurality of secondary data processing systems located in a network data processing system;
 - allocating inventory associated with the catalog to the plurality of secondary data processing systems;

² The examiner refers to *Whitehead*, but this appears to be a typographical error. From the context of the rejection, the term "Whitehead" apparently should be "*Tsevdos*." Applicants address the rejection accordingly.

receiving an order from one of the plurality of secondary data processing systems; and
processing the order, in response to receiving the order.

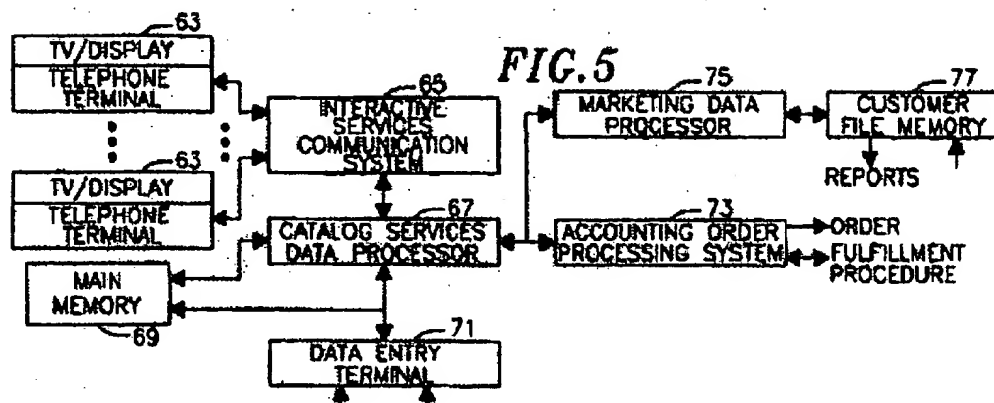
I.B The Examiner Has Failed to State a *Prima facie* Obviousness Rejection Against Claim 1

The examiner has failed to state a *prima facie* obviousness rejection against claim 1 because the features that the examiner states as being present in the references are not found or suggested by the references and because the examiner has failed to provide a proper motivation to modify or combine the references. Applicants address each of these facts in turn.

I.B.1 All of the Claim Features Are Not Present in the Cited References as Asserted by the Examiner

The examiner has failed to state a *prima facie* obviousness rejection because the features that the examiner states as being present in the references are not found or suggested by the references. In particular, neither *Westrope* nor *Tsevdos* show or suggest the claimed step of sending a catalog and user information to a plurality of secondary data processing systems, as claimed. In addition, neither *Westrope* nor *Tsevdos* show or suggest the claimed step of allocating inventory associated with a catalog to a plurality of secondary data processing systems.

Regarding the step of sending a catalog and user information to a plurality of secondary data processing systems, the examiner states that marketing processor 75 and accounting processor 73 are a plurality of secondary data processing systems used in the claimed manner. Office Action of Apr. 21, 2005, p. 2. In the response to arguments, the examiner states that, "...*Westrope* in fact disclose a plurality of secondary data (marketing data processor 75, accounting data processor 73) seen in fig. 5." However, the examiner's characterization of *Westrope* is incorrect.

Figure 5 of *Westrope* is as follows:

The text related to figure 5 is as follows:

Referring now to FIG. 5 in conjunction with the logic flow diagrams illustrated in FIG. 6 and 7, there is illustrated another embodiment of applicants' improved interactive electronic catalog process and system which, for example, could be operated in a single hotel, or within a chain of geographically dispersed hotels or on a system of carriers, for example cruise ships, trains or airplanes. As was described above in conjunction with FIG. 1, a user/customer would establish a communication path from a user TV terminal 63 through the communication system 65 for example a PBX telephone exchange network, marketed by AT&T, Rohm and other companies, within a hotel to a catalog service data processor 67, which is functionally and structurally similar to the apparatus described in connection with FIGS. 1 and 4. The user terminal may be the type described in conjunction with FIG. 1 or alternatively may be an interactive hookup with a touch tone telephone and a cable TV system to selectively display the requested catalog data and menu etc. on a particular TV channel. As described in connection with FIG. 1, the catalog data processor 67 has a main memory 69 and a data entry terminal 71 which may be of the types described in connection with FIGS. 1 and 4. **The electronic catalog data would be entered via data terminal 71 and stored in selectable memory locations in the main memory 69. Preferably applicants' system would include electronic catalog data for a plurality of different catalogs from different companies.** In addition, data entry terminal 71 may be utilized to enter special on-sale or promotional messages, either audio and/or visual, or a combination thereof. As has herein described in conjunction with FIGS. 1, 6, 7 and 8, the user may browse through various catalogs or may select an individual catalog or request specific product categories or services by type or select a product

by catalog product number. **If a user elects to order a specific product or service, this is done under menu control at a user terminal and the menu would prompt the user to enter the appropriate order data codes via, for example, a touchtone telephone pad on the user terminal 63.** *In response to receipt of such user order data codes, the catalog data processing signals the accounting and order processor 73, which is similar in function and structure to the order and accounting processor of FIGS. 1 and 3 to exercise the appropriate order processing requests to clear the customer/user's financial payment authorization and initiate the order fulfillment procedure to have the ordered products assembled and mailed to the address directed by the user/customer for that particular transaction. As herein above described in conjunction with FIGS. 1 and 3, the catalog data processor 67 in response to a customer/user order signals the marketing data processor 75, which is similar in structure and function to the marketing data processor described above in connection with FIGS. 1 and 4, to generate, unless the customer does not so authorize, customer profile marketing data in file 77 as described in FIGS. 6, 7 and 8. Accounting and order processor 73, which is structurally and functionally equivalent to the accounting and order processor described in FIGS. 1 and 3, initiates various accounting, financial payment authorization and/or assembly and shipping procedures as described in conjunction with FIGS. 6, 7 and 8. Accounting and order processor 73 as illustrated in FIG. 8 also in response to a command from the central data processor 67 initiates a software or program routine procedure to generate commission data for accumulating a commission file entry for the individual host hotel or site of the interactive catalog subsystem from which a particular order originated. As illustrated in FIG. 5, this differentiation of order source in order to develop an accounting commission credit for the party or entity from which site or which is responsible for originating a specific order can be accomplished by utilizing special codes for product orders originating from certain terminals, i.e. a code transmitted by the terminals 63 or alternatively by utilizing a prefix or suffix number or alphanumeric associated with a particular system host site which in conjunction with the catalog product number uniquely identifies the site as an originator of a specific product or service order.*

Westrope, col. 6, l. 58 through col. 7, l. 65. (Emphasis in italics to show portions relevant to the present argument; emphasis in bold to show portions cited by the examiner.)

Figure 5 and the accompanying text in *Westrope* do not teach sending a *catalog and user information* to a plurality of secondary data processing systems, as recited in claim 1. Even if accounting order processing system (73) and marketing data processor

(75) could be construed as a plurality of secondary data processing systems as claimed, a point that Applicants do not concede, *Westrope* does not show sending a catalog and user information to either system. Regarding the former system, *Westrope* sends only customer financial data and customer ordering data to accounting order processing system 73. *Westrope*, col. 7, ll. 28-36 (quoted above). None of the data sent to system 73 shows or suggests a catalog and user information as recited in claim 1. No teaching, suggestion, or incentive exists to send the claimed information to system 73 because that information already exists and has been used by catalog services data processor 67.

Regarding the latter system, *Westrope* only sends customer profile marketing data to marketing data processor 75. *Westrope*, col. 7, ll. 36-44 (quoted above). None of the data sent to processor 75 shows or suggests a catalog and user information as claimed. No teaching, suggestion, or incentive exists to send the claimed information to system 75 because that information already exists and has been used by catalog services data processor 67. Thus, neither of the systems to which the examiner refers are sent a catalog and user information in the manner claimed. Furthermore, *Tsevdos*, as described below, does not show or suggest anything that would cure the lack of disclosure in *Westrope* in this regard. Hence, the cited references do not show or suggest all of the claimed features as asserted by the examiner and the proposed combination does not result in the invention of claim 1. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

In addition, neither cited reference shows or suggests the step of allocating inventory associated with the catalog to the plurality of secondary data processing systems, as claimed. The examiner admits, and Applicants agree, that *Westrope* does not disclose this claimed step. Office Action of Apr. 21, 2005, p. 2. Nothing in *Westrope* suggests this claimed step. In addition, *Tsevdos* also does not show or suggest this claimed step.

The examiner asserts that *Tsevdos* does show this claimed step, citing the following portion of *Tsevdos*:

As an example, in the entertainment industry, particularly as it applies to companies involved in music typically known as music label companies, there has been a constant challenge for such companies to exploit their entire catalog. There is a need or

concern to make every album in their catalog available in any format and to never be out of stock with respect to that particular product. If the labels are indeed able to achieve that high level of expectation and availability, the retailer then is faced with the dilemma of allocating floor space to all of that available inventory regardless of the popularity of much of the stocked material. If this is not common practice, the retailer will be faced with losing a particular customer and clientele if the stock is not on-hand. In most instances, it is unrealistic to expect that a retailer will have sufficient floor space and financial resources to have an exhaustive stock of all products. As an example, the music industry is presently offering 60,000 to 100,000 albums by title and is growing at an extraordinary rate. Additionally, artists are continually engaged to expand their repertoire. This is particularly true when an artist has gained recent popularity and is a big hit with the consuming public, which may have resulted in an insatiable appetite for that artist's work. The retailer has the challenge of identifying what quantities are marketable over what period of time for that artist and any number of other artists and labels. The outlet merchandiser is fraught with the effort to stock those products and to have them available when approached by a customer who has that immediate and demanding interest in procuring a copy of that artist's work. Any miscalculation by the retailer evolves in what is known as stock-outs.

Tsevdos col. 1, l. 51 through col. 2, l. 14. (Emphasis to show portion cited by the examiner.)

The examiner states that “*Tsevdos* discloses allocating floor space to all of that available inventory regardless of the popularity of stocked materials and this kind of allocation can be associated with the catalog to the plurality of secondary processing systems as claimed...” Office Action of Apr. 21, 2005 p. 2. However, the examiner's assertion is incorrect in this case.

The cited portion of *Tsevdos* describes the problem faced by retailers in allocating *physical* floor space to actual *physical* inventory when some inventory items are not popular. Allocating physical floor space to inventory is distinct from allocating inventory associated with a catalog to a plurality of secondary data processing systems, as claimed. In fact, the cited portion of *Tsevdos* makes no mention of a plurality of secondary data processing systems. Although the examiner asserts that “this kind of allocation can be associated with the catalog to the plurality of secondary processing systems as claimed,” the examiner has pointed to no teaching, suggestion, or incentive based on the prior art

for this assertion. In the face of the stark contrast between allocating physical floor space for inventory and allocating inventory associated with a catalog to a plurality of secondary data processing systems as claimed, the examiner's unsubstantiated statement is insufficient to establish that *Tsevdos* either shows or suggests the claimed step.

Instead, the logical conclusion to draw from this stark contrast is that *Tsevdos* is sufficiently different from the claimed invention that *Tsevdos* does not show or suggest this claimed feature and that *Tsevdos* is wholly irrelevant to the invention of claim 1. Because the step of allocating inventory associated with the catalog to the plurality of secondary data processing systems is not show or suggested by either *Tsevdos* or *Westrope*, the references do not show or suggest all the features of claim 1. Accordingly, the proposed combination does not result in the claimed inventions and the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.B.2 The Examiner Has Failed to State Proper Motivation to Combine the References

The examiner has failed to state a *prima facie* obviousness rejection against claim 1 because the examiner has failed to state a proper motivation to combine the references.

The examiner has not stated any motivation that is based on the prior art to combine the references. For this reason alone, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

The examiner does state that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the service allocation module as taught by Whitehead³ into the system of *Westrope* because it would provide accountability of the communicated and networked information to have on-demand and real-time customer satisfaction.

Office Action of Apr. 21, 2005, p. 3.

However, this statement cannot be construed to be a proper motivation to combine the references or to further modify the proposed combination to result in the invention of claim 1. The rationale provided by the examiner is based on the examiner's personal belief as to a motivation, rather than being based on any teaching, suggestion, or

³ The reference to Whitehead is treated as a reference to *Tsevdos*

incentive in the prior art. Also, the examiner has only stated a possible advantage to combining the references. An advantage can not be substituted for a motivation to combine references because an advantage is not necessarily a motivation. For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that an ultra-high power lasers deliver more energy. One of ordinary skill may recognize that an ultra-high power laser would be a more useful tool to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid implementing the combination, even if he or she recognized the advantage. Thus, in this example, no motivation exists to combine the references.

In the case at hand, the examiner has not provided any reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. For this reason, the examiner's statement fails to provide a proper motivation to combine the references. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

In addition, the examiner used impermissible hindsight when fashioning the rejection of claim 1. If claim 1 had been obvious in view of *Westrope* and *Tsevdos*, then one of ordinary skill would have already combined the references and either created a product embodying the invention of claim 1 or publicly disclosed the invention of claim 1. Both *Westrope* and *Tsevdos* issued in 1998. In the intervening seven years, no one except Applicants have shown or suggested the invention of claim 1 and no one except the examiner has attempted to combine the references to achieve the invention of claim 1. In the computer and data processing arts, entire product lines and entire technologies become obsolete in this time period due to extremely rapid progress in the art. Thus, those of ordinary skill pay keen attention to advances as they appear. Given the value of the claimed inventions, had claim 1 been obvious in view of the cited references, then someone would have shown or suggested the invention of claim 1 in some manner. However, to Applicants' knowledge, no one has done so. Contrary to the failure of thousands of computer and software engineers to combine the references to achieve invention of claim 1, the examiner asserts that these ancient references render claim 1

obvious when the references considered as a whole. In the face of failure by thousands of both ordinary skill and extraordinary skill to achieve the claimed inventions in the intervening years, and in the face that the examiner failed to understand the references or claim 1, the examiner must have picked and chosen elements from the references and, using Applicants' own disclosure as a motivation, combine the elements. Hindsight may not be used as a substitute for the requirement under Graham v. John Deere Co., 383 U.S. 1 (1966) that the examiner provide a proper motivation to combine the references. Hence, the examiner has failed to state a proper motivation to combine the references and, accordingly, has failed to state a *prima facie* obviousness rejection against claim 1.

I.C Claim 1 is Non Obvious in View of *Tsevdos* and *Westrope*

I.C.1 *Tsevdos* Teaches Away from the Invention of Claim 1

Claim 1 is non-obvious in view of the proposed combination because *Tsevdos* specifically teaches away from the invention of claim 1. *Tsevdos* states that:

The present inventive contribution provides a digital data on-demand turnkey system at the customer premise wherein N number of servers provide for 100% of content distribution of remotely stored digitized information, which information may be previewed or reviewed in real-time, and product incorporating selected digitized information can be manufactured within a short response time to a customer's request at a point of sale location. *This technique is carried out without intermediate buffering or caching which minimizes costs particularly at those locations being served.* The Oxford Dictionary of Computing defines a real-time system as any system in which the time at which output is produced is significant. It states that this is usually because the input corresponds to some movement in the physical world, and the output has to relate to that same movement. It notes that the lag from input time to output time must be sufficiently small for acceptable timeliness.

Tsevdos, col. 2, l. 62 through col. 3, l. 12. (Emphasis supplied.)

Tsevdos specifically states that the described method is carried out *without intermediate buffering or caching*. Doing so minimizes costs, particularly at those locations being served. In contrast, the invention of claim 1 requires sending a catalog and user information to a plurality of *secondary data processing systems* and allocating inventory associated with the catalog to the plurality of *secondary data processing*

systems. *Tsevdos* states that the described method is carried out without intermediate buffering or caching. The invention of claim 1 contains features that move information to secondary data processing systems, which directly contradicts *Tsevdos*' teachings. Because *Tsevdos* teaches away from the invention of claim 1, no one of ordinary skill would be motivated to combine the references at all, much less to combine the references in a manner sufficient to achieve the invention of claim 1. Accordingly, claim 1 is non-obvious in view of *Tsevdos* and *Westrope*.

I.C.2 The References Address Different Problems

In viewing the references as a whole, one of ordinary skill would look to the problems addressed by the references in determining whether to combine the references. *Tsevdos* and *Westrope* are in different fields and address different problems than those addressed in claim 1. As shown above, *Tsevdos* pertains to the problem of retailers having to allocate physical floor space regardless of the popularity of much of the stocked material. *Tsevdos* solves this problem by having a digital information distribution system and manufacturing product at the physical point of sale. In contrast, *Westrope* pertains to the problem of "selectively transmitting and displaying at a customer/user's telephone terminal interactive catalog data selected by the user." *Westrope*, col. 2, ll. 41-43. These two problems have nothing to do with each other. Thus, no one of ordinary skill would have any reason or motivation to look to *Tsevdos* for problems that arise in *Westrope*. In still further contrast, the invention of claim 1 pertains to the problem of processing commercial transactions of a user over a large geographic area. Thus, the problem addressed by the invention of claim 1 is wholly irrelevant to the problems addressed by either *Westrope* or *Tsevdos*. Hence, one of ordinary skill would have no reason or motivation to look to *Westrope* or *Tsevdos* to solve the problem addressed by the invention of claim 1. Because the references solve different problems, each different than the problem solved by the invention of claim 1, one of ordinary skill would have no motivation to combine *Tsevdos* and *Westrope* to achieve the invention of claim 1. Accordingly, claim 1 is non-obvious in view of *Tsevdos* and *Westrope*.

I.D Remaining Claims

Claim 32 contains limitations similar to those presented in claim 1. Thus, the examiner has failed to state a *prima facie* obviousness rejection against claim 32 for the reasons presented above. Similarly, claim 32 is non-obvious for the reasons presented above.

Claims 2-8, 11-15, 33-39, and 42-46 all depend from claims 1 and 32. These claims are patentable over the cited references for the same reasons as the independent claims. The examiner has failed to state a *prima facie* obviousness rejection against these claims for the reasons presented above.

In addition, the dependent claims contain additional features not shown or suggested by either *Westrope* or *Tsevdos* when the references are considered as a whole. For example, neither reference shows or suggests sending an update to the catalog to the plurality of secondary data processing systems, as claimed in claim 2. The examiner's assertion to the contrary is incorrect in view of the analysis presented vis-à-vis claim 1. Regarding claims 6, 7, 38, and 39, neither reference shows or suggests periodically obtaining necessary shopping cart data from at least one secondary data processing system or forwarding the necessary shopping cart data to other secondary data processing systems, as claimed. The examiner's assertion to the contrary is incorrect in view of the analysis presented vis-à-vis claim 1.

Regarding claims 4, 5, 36, and 37, the examiner admits and Applicants agree that neither *Westrope* nor *Tsevdos* teaches allocation of the inventory upon a detection of a condition, as claimed. The examiner states that "it is well known to set a condition when determining whether or not an inventory is necessary because it would help determining the location of missing products, the examiner takes Official notice as such." Office Action of Apr. 21, 2005, p. 3. Claims 4, 5, 36, and 37 should be allowable over the cited references in view of the "Official notice" for the same reasons presented above because the "Official notice" does not cure any of the deficiencies of the base rejection of the independent claims. In addition, the examiner has stated a fact without stating a motivation to combine the fact with the references to achieve the claimed inventions. Thus, the examiner has failed to state a *prima facie* obviousness rejection against these claims.

In addition, the examiner has stated a fact without foundation or support. Applicants request that the examiner provide a basis for the asserted fact, submit an affidavit under 35 C.F.R. § 104(d)(2) to provide a foundation for the asserted fact, or allow the claims.

I.E Summary of Allowability of Claims 1-8, 11-15, 32-39, and 42-46

The examiner has failed to state *prima facie* obviousness rejections of claims 1-8, 11-15, 32-39, and 42-46 because the references do not teach all of the features as asserted by the examiner, because the proposed combination does not result in the claimed inventions, and because the examiner has not stated a proper motivation to combine the references. In addition, *Tsevdos* teaches away from the claimed inventions, the references address different problems, and the references are ancient in the computer arts. For these reasons, no one would be motivated to combine the references or to further modify the proposed combination. Accordingly, the claims are non-obvious in view of *Westrope* and *Tsevdos*. Thus, the rejection against these claims under 35 U.S.C. § 103(a) has been overcome.

II. Asserted Obviousness of Claims 9, 10, 40, and 41

II.A Basis of Rejections

The examiner rejects claims 9, 10, 40, and 41 under 35 U.S.C. § 103(a) as obvious over *Westrope* in view of *Tsevdos* and further in view of *Yamazoe et al.*, System of and Method for Exchanging Information on Commercial Transaction Exploiting Electronic Catalog and System of and Method for Collecting and Storing Marketing Information, U.S. Patent Application Publication 2001/0032148 (Oct. 18, 2001). This rejection is respectfully traversed.

The examiner states that:

As per claims 9, 10, 40 and 41, *Westrope et al* do not teach a catalog that is sent in a markup language and wherein the markup language is extensible markup language but *Yamazoe et al* teach an application service on a network having a WWW (World Wide Web) voluntarily managed by the selling enterprise through the use of the XML (extensible markup language).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the service allocation module as taught by Whitehead into the system of *Westrope* because it would provide accountability of the communicated and networked information to have on-demand and real-time customer satisfaction. It would have been obvious to one of ordinary skill in the art to utilize the extensible markup language (XML format) taught by *Yamazoe* et al into the combined system of *Westrope* and *Tsevdos* because it would ensure a safe transmission of the information or document through a network.

Office Action of Apr. 21, 2005, pp. 3-4.⁴

II.B The Examiner Has Failed to State a *Prima facie* Obviousness Rejection

II.B.1 The Base Rejection Against Claims 1 and 32 Is Flawed

As shown above, the base rejection against claims 1 and 32 is flawed for the reasons given above. The examiner's statements in rejecting claims 9, 10, 40, and 41 do not cure the deficiencies in the rejection against the corresponding independent claims. Accordingly, the examiner has failed to state *prima facie* obviousness rejections of claims 9, 10, 40, and 41 for the reasons given above.

II.B.2 The Examiner Has Failed to State a Proper Motivation to Combine the References

The examiner has not stated a motivation to combine the references. Thus, the examiner has failed to a *prima facie* obviousness rejection against claims 9, 10, 40, and 41.

The examiner does state that, "It would have been obvious... to utilize the extensible markup language (XML format) taught by *Yamazoe* et al into the combined system of *Westrope* and *Tsevdos* because it would ensure a safe transmission of the information or document through a network." However, this statement only describes a possible advantage. As shown above, an advantage is not equivalent to a motivation and the examiner has not shown how the proposed advantage constitutes a motivation to combine the cited references. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claims 9, 10, 40, and 41.

⁴ The reference to Whitehead is treated as a reference to *Tsevdos* for the reasons described above.

In addition, the examiner must have used impermissible hindsight when fashioning the rejection. *Yamazoe* appears to be offered for the sole proposition that transmitting XML documents is known. However, when the reference is considered as a whole, *Yamazoe* shows an electronic catalog system entirely different from the claimed system. *Yamazoe* is also entirely different from either *Westrope* or *Tsevdos*. Thus, no one of ordinary skill in the art has no teaching, suggestion, or incentive to combine the three references, unless Applicants' own disclosure was used as the basis for the motivation. Accordingly, the examiner has used impermissible hindsight as a substitute for a motivation to combine the references. Accordingly, the examiner has again failed to state a *prima facie* obviousness rejection.

II.C Claims 9, 10, 40, and 41 Are Non-Obvious in View of the Cited References

In addition, claims 9, 10, 40, and 41 are non-obvious in view of the cited references for the reasons presented vis-à-vis claim 1. For example, the *Tsevdos* teaches away from the claimed inventions, *Tsevdos* and *Westrope* address different problems, and *Tsevdos* and *Westrope* are ancient references in the computer arts. Thus, no one would be motivated to combine the references or to add *Yamazoe* to the references.

In addition, *Yamazoe* is cited merely for the proposition that transmitting documents in XML format is known. However, when the reference is considered as a whole, one notes that *Yamazoe* is directed to an entirely different catalog system than that claimed. *Yamazoe* is also entirely different than either *Tsevdos* or *Westrope*. No one would have a reason to look to *Yamazoe* to solve problems addressed by *Tsevdos* or *Westrope*; thus, no motivation exists to combine *Yamazoe*, *Tsevdos*, or *Westrope*. Accordingly, claims 9, 10, 40, and 41 are non-obvious in view of these references when the references are considered as a whole.

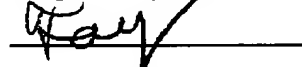
III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: July 21, 2005

Respectfully submitted,



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